

S/N: 10/647,698

Atty Dkt No. GP-302475 / GM0328PUS

REMARKS

Claims 1, 4, 6-13, and 15-21 are pending. Claim 21 is allowed. Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims. Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eipper et al. (6,224,120). Claims 12, 13, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vermeulen (6,022,057) in view of Eipper et al. Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eipper et al. in view of Tohda et al. (6,447,049). Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vermeulen in view of Eipper et al.

Applicants have cancelled claims 1 and 17-20. Applicants have amended claims 4, 6, 8, and 11.

The Examiner indicated that "[c]laims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Applicants have amended claim 8 to be rewritten in independent form including all of the limitations of the base claim, i.e., claim 1, from which claim 8 originally directly depended. Applicants therefore submit that amended claim 8 is allowable. Claims 9 and 10 ultimately depend from claim 8, and therefore are no longer dependent upon a rejected base claim. Accordingly, Applicants submit that claims 9 and 10 are allowable.

Claims 4, 6, and 11 have been amended to depend from claim 8, and are therefore allowable for at least the same reasons that claim 8 is allowable. Claim 7 depends from claim 6, which has been amended to depend from claim 8; therefore, claim 7 is allowable for at least the same reasons that claim 8 is allowable. Claim 1 has been cancelled.

Applicants note the allowance of claim 21 with appreciation.

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Claims 12, 13, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vermeulen in view of Eipper et al. Claim 12 recites, *inter alia*, “a first one-piece metal member.” (emphasis added) In rejecting claim 12, the Examiner states that “Vermeulen (6,022,057) discloses a vehicle bumper comprising: a first piece member 5....” Vermeulen teaches that member 5 is plastic, not metal. More specifically, Vermeulen teaches that “cover element 5 [is] manufactured from deformable plastic.” Vermeulen, column 2, lines 43-44. (emphasis added).

The Examiner admits that “Vermeulen lacks the first piece member being metal.” The Examiner relies on Eipper et al. for “a first metal piece member 12.”

As motivation or suggestion to modify the plastic cover element 5 of Vermeulen to be metal, the Examiner provides “to provide added crash strength to the vehicle.” However, such a modification would change the principle of operation of Vermeulen. Vermeulen states, in the summary of the invention, that the “thus manufactured construction has a robust appearance but is also capable of absorbing energy during a collision. In the case of a light collision only the plastic cover element of the construction will deform. After the collision the cover element will then be able to reassume its original form.” Vermeulen, column 1, lines 45-49. (emphasis added). Thus, the principle of operation of Vermeulen requires a “deformable plastic” cover element 5 (*Id.*, at column 2, lines 43-44) to deform and then reassume its original form; making the cover element 5 of metal instead of deformable plastic would not produce the result intended by Vermeulen.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2141.01(VI), citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Since the modification of Vermeulen proposed by the Examiner would change the principle of operation of Vermeulen, “the teachings of the references are not sufficient to render the claims *prima facie* obvious,” as recited by MPEP § 2141.01(VI). Accordingly,

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Applicants submit that the Examiner has not established *prima facie* obviousness with respect to claim 12, and therefore the rejection of claim 12 is improper.


Claims 13, 15, and 16 ultimately depend from claim 12 and are therefore allowable for at least the same reasons that claim 12 is allowable.

CONCLUSION

Applicants believe the foregoing to be fully responsive to the Office Action mailed November 28, 2005. The remarks in support of the amended claims and the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted

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